



The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD A. SIMON

Appeal No. 2001-1008
Application No. 08/971,097

ON BRIEF

Before BARRETT, FLEMING, and RUGGIERO, **Administrative Patent Judges**.

FLEMING, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1 through 13, all the claims pending in the present application. Claims 14 and 15 have been canceled. We note that proposed claims 16 through 18, filed by an amendment after final, were not entered, and thereby are not present in the application.

The invention relates to a photobooth that produces special artistic effects in an image using digital image processing. See page 1 of Appellant's specification.

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The only independent claim present in the application, claim 1, is reproduced as follows:

1. A photobooth, comprising:

an electronic camera for capturing and producing a digital image of a customer;

an image processing computer for processing the digital image to apply a special effect to the image;

a display for displaying the processed digital image to the customer;

a printer for printing the processed digital image; and

means for producing a motion image display simulating the sequential production of the processed image and displaying the motion image while the image is being processed and printed.

References

The references relied on by the Examiner are as follows:

Wolfe et al. (Wolfe)	5,446,515	Aug. 29, 1995
Bulman	5,623,587	Apr. 22, 1997
		(filed Jun. 12, 1995)
Bishop	5,810,599	Sep. 22, 1998
		(filed Jan. 26, 1994)
Nishimura	GB 2 262 013 A	Feb. 6, 1993

Rejections at Issue

Claims 1 through 3 and 7 through 12 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wolfe and Nishimura.

Claims 4 through 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Wolfe, Nishimura and Bulman.

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Claim 13 stands rejected under 35 U.S.C. § 103 as being unpatentable over Wolfe, Nishimura and Bishop.

Rather than repeat the arguments of Appellant or the Examiner, we make reference to the brief and answer for the respective details thereof.

OPINION

With full consideration being given the subject matter on appeal, the Examiner's rejection and the arguments of Appellant and the Examiner, for the reasons stated *infra*, we reverse the Examiner's rejection of claims 1 through 13 under 35 U.S.C. § 103.

We first will address the rejection of claims 1 through 3 and 7 through 12 under 35 U.S.C. § 103 as being unpatentable over Wolfe and Nishimura. In rejecting claims under 35 U.S.C. § 103, the Examiner bears the initial burden of establishing a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). *See also In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984). The Examiner can satisfy this burden by showing that some objective teaching in the prior art or knowledge generally available to one of ordinary skill in the art suggests the claimed subject matter.

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In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Only if this initial burden is met does the burden of coming forward with evidence or argument shift to the Appellants. **Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. **See also Piasecki**, 745 F.2d at 1472, 223 USPQ at 788.

An obviousness analysis commences with a review and consideration of all the pertinent evidence and arguments. "In reviewing the [E]xaminer's decision on appeal, the Board must necessarily weigh all of the evidence and arguments." **In re Oetiker**, 977 F.2d at 1445, 24 USPQ2d at 1444. "[T]he Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion." **In re Lee**, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). With these principles in mind, we commence review of the pertinent evidence and arguments of Appellant and Examiner.

Appellant argues that there is no suggestion in either Wolfe or Nishimura that teaches or suggest entertaining the customer while their images are being printed. In particular, the Appellant argues that they recognize a problem of boredom while an image is being processed by a photobooth. The Appellant

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argues that the Examiner has used Appellant's own disclosure to provide the motivation for the combination. The Appellant argues that the Examiner is using classic hindsight reconstruction and it is improper for making an obvious rejection.

When determining obviousness, "the [E]xaminer can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or individual to combine the relevant teachings of the references.'" ***In re Lee***, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), ***citing In re Fritch***, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). "Board conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence.'" ***In re Dembiczak***, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617. "Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact." ***Dembiczak***, 175 F.3d at 999, 50 USPQ2d at 1617, ***citing McElmurry v. Arkansas Power & Light Co.***, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

In addition, our reviewing court requires the PTO to make specific findings on a suggestion to combine prior art references. ***In re Dembiczak***, 175 F.3d 994, 1000-01, 50 USPQ2d

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1614, 1617-19 (Fed. Cir. 1999). Our reviewing court states further that the "factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority." *In re Lee*, 277 F.3d at 1344, 61 USPQ2d at 1434 (Fed. Cir. 2002). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983).

We fail to find that the Examiner has provided the required evidentially findings to support the Examiner's combination of the prior art references of Wolfe and Nishimura. The Examiner has instead provided conclusory statements and has not established genuine issues of material fact. We note in the Examiner's answer, the Examiner has provided reasons for the combination but those reasons are only a repeat of what the Appellant's disclosure has stated. The Examiner has not shown that these reasons are established in the prior art.

The Examiner responds to the Appellant's arguments by stating that it is proper for the Examiner to take in account the knowledge which is within the level of ordinary skill in the art at the time the invention is made. When the Federal Circuit was

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presented a similar argument, the Court responded that there is no precedence that holds that objective analysis, proper authority, and reasoned findings can be omitted from Board decisions. **See In re Lee**, 277 F.3d at 1344, 61 USPQ2d at 1435. Therefore, we will not sustain the Examiner's rejection of claims 1 through 3, and 7 through 12 as being unpatentable under 35 U.S.C. § 103.

In regard to the rejection of claims 4 through 6 and 13 under 35 U.S.C. § 103, we note that the Examiner relies on the same reason to combine Wolfe and Nishimura. Therefore, for the same reasons as above, we will not sustain this rejection.

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In view of the foregoing, we have not sustained the rejection of claims 1 through 13 under 35 U.S.C. § 103.

REVERSED

LEE E. BARRETT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
MICHAEL R. FLEMING)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOSEPH F. RUGGIERO)	
Administrative Patent Judge)	

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